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EXAMINER

KAVANAUGH, JOHN T

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 13

Application Number: 09/851,911

Filing Date: May 09, 2001

Appellant(s): POSA, JOHN G.

Mr. John J. Posa
For Appellant

MAILED
APR 02 2003

GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 26, 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1,3,4, and 11-16 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

WO 91/11924	Ellis	8-1991
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5,084,988	BERGER	2-1992
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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,3,4,13 and 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 9111924 (Ellis).

Ellis teaches footwear substantially as claimed including a sole portion having a bottom surface with a densely packed matrix of projections (projections are formed by slits 151; see figures 11A,11B,8,9) and a non-partitioned border surrounding the matrix (see figures 10A,10B and 10C). It would appear the projections have the dimensions as claimed ("nominal length of 3/16 or greater" and "nominal width of 1/8 inch or greater") but assuming they don't, the selection of a suitable size of the projections, would appear to constitute no more than optimization of size by routine experimentation inasmuch as

a number of thickness would appear to be suitable depending on the individual wearer and the type of footwear being constructed. That is, the size of the projections (the thickness of the sole) is recognized in the art to be a variable that is result effective. Generally, it is considered to have been obvious to develop workable or even optimum ranges for such variables. For example, see *In re Aller*, 220 F.2d 454, 105 USPQ 233 (CCPA 1955) and *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Since the applicant has not demonstrated or even alleged that the specifically claimed size produces unexpected results, it is our conclusion that it would have been obvious for an artisan with ordinary skill to determine a workable or even optimum size for the projections and thereby arrive at the size (i.e. length and width) as claimed by the applicant.

Regarding claims 3 and 13-14, figures 11A and 11B of Ellis show the projections having square and hexagonal shapes. Ellis also teaches the bottom surface can have a plurality of different shapes including circles, see page 19, line 31 to page 20, line 34

The projections are inherently capable of being selectively removed and therefore leave personalized imprints on wet sand or other surfaces. Moreover, Ellis teaches the sole portions can be removed, "The darkened squares indicate that shoe sole portions can be removed to provide tread or cleat-like shoe soles", pg. 20, lines 3-5.

4. Claims 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924.

Ellis teaches footwear substantially as claimed (see the rejection above) except for the projections being triangular and rectangular. Figures 11A and 11B of Ellis show the projections having square and hexagonal shapes. Ellis also teaches the bottom surface can have a plurality of different shapes including circles, see page 19, line 31 to page 20, line 34. It would have been an obvious matter of design choice to make the projections of whatever form or shape was desired or expedient such as being triangular and rectangular. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924.

Ellis teaches footwear having a sole portion having a bottom surface with a densely packed matrix of projections extending there from (see figures 11A and 11B) wherein each projection is inherently capable of being removed (moreover, Ellis teaches that the sole portions can be removed; see pg. 20, lines 3-5) substantially as claimed except for the footwear comprising a sandal or thong. Ellis teaches "This invention relates generally to the structure of shoes. More, specifically...athletic shoes", pg. 1, lines 4-6. The term shoes in the art include sandals. Therefore, it would have been obvious to provide the sole portion as taught above as part of a sandal or thong, to provide traction to the footwear.

The projections are inherently capable of being selectively removed and therefore leave personalized imprints on wet sand or other surfaces. Moreover, Ellis

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teaches the sole portions can be removed, "The darkened squares indicate that shoe sole portions can be removed to provide tread or cleat-like shoe soles", pg. 20, lines 3-5.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis '924 in view of US 5084988 (Berger).

Ellis teaches footwear having a sole portion having a bottom surface with a densely packed matrix of projections extending there from (see figures 11A and 11B) wherein each projection is inherently capable of being removed (moreover, Ellis teaches that the sole portions can be removed; see pg. 20, lines 3-5) substantially as claimed except for the sole portion being at least partially transparent to enable a user to look through the sole portion. Berger teaches a sole portion that is partially transparent (8,9,3,4 are all transparent) to permit viewing of the toe tips. It would have been obvious to provide the sole as taught by Ellis to being transparent, as taught by Berger, to permit to permit viewing the toes within the shoe to determine whether the shoe is too small.

Regarding the functional claim language, the shoe sole as taught above is transparent and the projections are inherently capable of being removed and therefore the user is inherently capable of looking the shoe sole and remove the projections. Moreover, Ellis teaches the sole portions can be removed, "The darkened squares indicate that shoe sole portions can be removed to provide tread or cleat-like shoe soles", pg. 20, lines 3-5.

(11) Response to Argument

Group 1:

Appellant argues that shoe sole structure of Ellis is for a different purpose.

All of the functional claim language and statements of intended use (i.e. the purpose) do not make an otherwise unpatentable claim patentable. It is believed to be well settled that "recitation with respect to manner in which claimed apparatus is intended to be employed does not differentiate claimed apparatus from prior art apparatus satisfying structural limitations of that claimed" Ex parte Masham 2 USPQ2nd 1647. Also see Ex parte Casey 152 USPQ 235. The law of anticipation does not require that an anticipatory reference teach what the applicant is claiming or has disclosed, but only that the claims "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly Clark Corp., 713 F.2d 760, 218 USPQ 871 (Fed Cir. 1983). Furthermore, it is only necessary that the reference include structure capable of performing the recited function in order to meet the functional limitations of a claim. See In re Mott, 557 F.2d 266, 194 USPQ 305 (CCPA 1977). Since the reference device has all of the same structural elements, as noted above, it would clearly seem to be inherently capable of performing the functions as claimed.

Applicant argues that his invention teaches an unexpected result in the ability to remove the projections, and based upon available materials, projections in the claimed size range would optimize that purpose.

The examiner, respectively, disagrees with appellant. The removal of the projections does not give any unexpected result. It is known in the art that the bottom of footwear leave an imprint on wet sand. If some projections are removed obviously the these areas will not leave an imprint on the wet sand. Regarding the "ability to remove the projections", the projects of appellants projections can be removed by hand, with a knife, nail clippers, spoon, etc., see specification page 3, lines 19-20. The projections of Ellis can be removed by the same means.

Appellant argues that the section of Ellis that are removed are filled with some other materials such as a tread or cleat. Therefore, "the teachings of Ellis point to a shoe sole that either remains intact or is modified to provide even more traction, the reference teaches away from projections removability."

In response, the sections that are replaced with other tread or cleat would still leave an imprint on wet sand.

Group 2:

Applicant argues "the Examiner cites Figures 10A, 10B, and 10C of Ellis, which do appear to show a non-partition, but in the examples illustrated, it is not around a densely packed matrix of the projections".

In response, Ellis teaches the densely packed matrix of projections (projections are formed by slits 151) are shown in figures 11A, 11B, 8, 9 and the non-partitioned border surrounding the matrix are shown in figures 10A, 10B and 10C. The slits are all labeled 151 in these figures. Figures 11A and 11B merely show another embodiment of

the form the slits can have. Figures 11A and 11B only show a portion of the bottom of the shoe sole.

Group 3:

Regarding the Ellis in view of Berger rejection, Appellant argues that the prior art doesn't suggest a reason to combine these references.

In response, motivation and/or suggestion to combine is taught by Berger inasmuch as Berger teaches a sole portion that is partially transparent (8,9,3,4 are all transparent) to permit viewing of the toe tips, see col. 1, lines 38-44. It would have been obvious to provide the sole as taught by Ellis to being transparent, as taught by Berger, to permit to permit viewing the toes within the shoe to determine whether the shoe is too small.

Appellant also argues that the reason suggested by the examiner is a different than reason than what applicant's is used for.

It has been held that "[a]s long as some motivation or suggestion to combine references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. In re Beattie, 24 USPQ2d 1040, 1042 (1992); also see In re Kronig, 539 F.2d 1300, 1304, 190 USPQ 425, 427-28 (CCPA 1976), and also see In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Group 4:

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It appears Appellant is arguing that since a sandal or thong don't desire as much traction as an athletic shoe then it would be a stretch to conclude that the sole of Ellis could be part of a sandal or thong.

In response the examiner disagrees with this point. Sandals and thongs are known in the art to desire traction to. Specifically, sports sandal have a plurality of traction elements on the bottom of the shoe sole.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Primary Examiner
Art Unit 3728

TK
April 1, 2003

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